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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/751,429

Applicant(s)

SEET ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed on 27 October 2004 was successful in overcoming the rejection under 35 U.S.C. 102(e) based on McCurdy et al. A rejection based on new prior art follows. The amendment (p. 11 bottom) mentions a terminal disclaimer, but none was found by the examiner, so a new double patenting rejection also follows.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 depends on itself. This rejection can be overcome by making claim 22 dependent on claim 21.

### *Double Patenting*

4. The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5, 7-9, 11-14, 16-18 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. patent US006701301B2 (the '301 patent) in view of Ho (US005909207A, the '207 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because they are materially different in only two obvious ways.
6. First, a phrase was deleted from each of the '301 patent claims to respectively form the instant claims 1 and 2. At claim 1 of the '301 patent, the phrase "in a browsable electronic book configured to display flipping pages", which appears at col. 24, lines 24-26, was deleted to form instant claim 1. The same phrase was deleted from claim 2 of the '301 patent (col. 24 lines 41-43) to form instant claim 2. It is always obvious to eliminate limitations.
7. Second, the claims have been limited to a book representation including a first and a second book thickness indicator, which is not taught by the '301 patent. However, the '207 patent teaches a book representation including a first and a second book thickness indicator (col. 9 lines 46-54). Because the '207 patent teaches that this provides the user with an approximate idea of where the current page is located in the book, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of the '207 patent to those of the '301 patent.
8. There are also two differences in choice of words between the two claims "2". In the '301 claim 2 (col. 24 lines 47 and 48) the words "clicking" and "corresponding to" have been replaced in the instant claim 2 respectively with "receiving a click" and "describing". Neither of these changes affects the patentability of the claims.
9. Claims 11 and 20 are respectively the system and computer program product equivalents of method claim 1.
10. The '207 patent also teaches the added limitations of the following dependent claims: 3, 5, 12 and 14 (col. 16 lines 5-6); 25 (col. 17 line 33); claims 4 and 13 (Fig. 5A described at col. 15 lines 61-67); 7, 8, 16, 17 and 23-26 (Figs. 6A & 6B, described at col. 17 line 3 to col. 18

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line 10); and claims 9, 18, 21 and 22, where a *bookmark* reads on an address indicator and a jump cursor (col. 12 lines 53-64 and col. 13 lines 42-50).

11. Claims 6 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the references cited above (para. 5), and further in view of Sarra (US pat. 5,053,762). The references cited above do not teach a bending page. Sarra teaches a bending page (col. 2 line 48). Because Sarra teaches that this is a particularly appealing special effect 9col. 1 lines 17-18), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a the teachings of Sarra to those of the references cited in para. 5 above.
12. Claims 10 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the references cited above (para. 5), and further in view of McCurdy et al. (US pat. 5,053,762). The references cited above do not teach activating an embedded link on a displayed page. McCurdy et al. teaches activating an embedded link on a displayed page (para. [0097]). Because McCurdy et al. teaches that this facilitates interaction with advertisers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a the teachings of McCurdy et al. to those of the references cited in para. 5 above.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-5, 7-14 and 16-20 is rejected under 35 U.S.C. 103(a) as being obvious over McCurdy et al. in view of Ho (US005909207A, the '207 patent).
15. McCurdy et al. teaches (independent claims 1, 2, 11 and 20) a method and system for electronically inserting advertisement into displayed content, and a computer program product containing said method, the method comprising the steps of: displaying magazines,

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of approximately 200 page size, with the pages having the appearance, layout and quality similar to that of a book-like printed publication (para. [0007], [0008], [0201] and [0358]), which reads on organizing sequentially a content into more pages than what are simultaneously viewable on a single display, dividing said content into *pages*, which reads on discrete content amounts, and displaying at least two of said discrete content amounts (the two being *opposing pages to a given page*), and said displaying step comprising displaying two of said discrete content amounts in a book representation; inserting an advertisement within said content, said content now including said advertisement (para. [0019], 2-3 lines from the end); and displaying a page flipping so as to advance to a discrete content amount other than said at least two discrete content amounts (para. [0037]).

16. McCurdy et al. does not teach that said book representation includes a first and a second book thickness indicator. The '207 patent teaches a book representation including a first and a second book thickness indicator (col. 9 lines 46-54). Because the '207 patent teaches that this provides the user with an approximate idea of where the current page is located in the book, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of the '207 patent to those of McCurdy et al.
17. McCurdy et al. also teaches (claims 10 and 19) activating an embedded link (para. [0097]).
18. The '207 patent also teaches the added limitations of the following dependent claims: 3, 5, 12 and 14 (col. 16 lines 5-6); 25 (col. 17 line 33); claims 4 and 13 (Fig. 5A described at col. 15 lines 61-67); 7, 8, 16, 17 and 23-26 (Figs. 6A & 6B, described at col. 17 line 3 to col. 18 line 10); and claims 9, 18, 21 and 22, where a *bookmark* reads on an address indicator and a jump cursor (col. 12 lines 53-64 and col. 13 lines 42-50).
19. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being obvious in view of the references cited above (para. 14), and further in view of Sarra (US pat. 5,053,762). The references cited above do not teach a bending page. Sarra teaches a bending page (col. 2 line 48). Because Sarra teaches that this is a particularly appealing special effect (col. 1 lines 17-18), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a the teachings of Sarra to those of the references cited in para. 14 above.

**Conclusion**

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
21. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
23. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.
24. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues,

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or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

25. Applicant may have after final arguments considered and amendments entered by filing an RCE.

26. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

28 December 2004

DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622